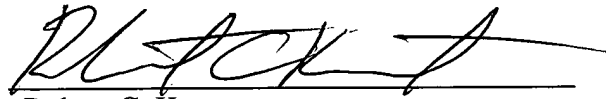


☒ Return Receipt Postcard

☒ Supplemental Appeal Brief (in triplicate)

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. Kowert', written over a horizontal line.

Robert C. Kowert

Reg. No. 39,255

ATTORNEY FOR APPLICANT(S)

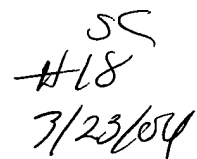
Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.

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Date: March 3, 2004



Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.

## **I. REAL PARTY IN INTEREST**

The statement from the original Appeal Brief is herein incorporated by reference.

## **II. RELATED APPEALS AND INTERFERENCES**

The statement from the original Appeal Brief is herein incorporated by reference.

## **III. STATUS OF CLAIMS**

Claims 1-5, 7-23, 28, 41, 42, 44-47, 49-51, 53-70, 73 and 74 are pending and are the subject of this appeal. A clean copy of claims 1-5, 7-23, 28, 41, 42, 44-47, 49-51, 53-70, 73 and 74, as on appeal, was included in the Appendix to the original Appeal Brief and is incorporated by reference for the Appendix hereto.

## **IV. STATUS OF AMENDMENTS**

Subsequent to the Final Rejection, an amendment was filed canceling claims 71 and 72. According to the Advisory Action of July 2, 2003, the amendment canceling claims 71 and 72 has been entered. No further amendments to the claims have been filed since the Examiner reopened prosecution. The Appendix of the original Appeal Brief reflects the current state of the claims.

## **V. SUMMARY OF THE INVENTION**

The Summary of the Invention from the original Appeal Brief is herein incorporated by reference.

## **VI. ISSUES**

1. Whether claims 1-5, 7-15, 22, 23, 28, 41, 42, 49 and 74 are unpatentable over Theimer et al. (U.S. Pat. 5,627,517) in view of DeRoche (U.S. Pat. 6,429,810) under 35

U.S.C. § 103(a).

2. Whether claims 50, 53, 55-63, 67, 69 and 70 are unpatentable over DeRoche (U.S. Pat. 6,429,810) in view of Theimer et al. (U.S. Pat. 5,627,517) under 35 U.S.C. § 103(a).

3. Whether claims 16, 17, 64 and 65 are unpatentable over Theimer et al. (U.S. Pat. 5,627,517) in view of DeRoche (U.S. Pat. 6,429,810) and further in view of Ross et al. (U.S. Pat. 6,332,098) under 35 U.S.C. § 103(a).

4. Whether claims 18, 20, 21 and 66 are unpatentable over Theimer et al. (U.S. Pat. 5,627,517) in view of DeRoche (U.S. Pat. 6,429,810) and further in view of Welles, II et al. (U.S. Pat. 5,686,888) under 35 U.S.C. § 103(a).

5. Whether claim 19 is unpatentable over Theimer et al. (U.S. Pat. 5,627,517) in view of DeRoche (U.S. Pat. 6,429,810) and further in view of Wortham (U.S. Pat. 5,999,091) under 35 U.S.C. § 103(a).

6. Whether claims 44-47, 51, 54, 68 and 73 are unpatentable over Theimer et al. (U.S. Pat. 5,627,517) in view of DeRoche (U.S. Pat. 6,429,810) and further in view of Shavit et al. (U.S. Pat. 4,799,156) under 35 U.S.C. § 103(a).

## **VII. GROUPING OF CLAIMS**

Claims 1-3, 7, 8, 12-15 and 18-22 stand or fall together for purposes of this appeal only.

Claim 4 stands or falls alone.

Claim 5 stands or falls alone.

Claim 9 stands or falls alone.

Claim 10 stands or falls alone.

Claim 11 stands or falls alone.

Claims 16 and 17 stand or fall together for purposes of this appeal only.

Claim 23 stands or falls alone.

Claim 28 stands or falls alone.

Claim 41 stands or falls alone.

Claim 42 stands or falls alone.

Claim 44 stands or falls alone.

Claim 45 stands or falls alone.

Claim 46 stands or falls alone.

Claim 47 stands or falls alone.

Claim 49 stands or falls alone.

Claim 50 stands or falls alone.

Claim 51 stands or falls alone.

Claims 53, 63 and 66 stand or fall together for purposes of this appeal only.

Claim 54 stands or falls alone.

Claim 55 stands or falls alone.

Claim 56 stands or falls alone.

Claim 57 stands or falls alone.

Claim 58 stands or falls alone.

Claim 59 stands or falls alone.

Claim 60 stands or falls alone.

Claim 61 stands or falls alone.

Claim 62 stands or falls alone.

Claims 64 and 65 stand or fall together for purposes of this appeal only.

Claim 67 stands or falls alone.

Claim 68 stands or falls alone.

Claim 69 stands or falls alone.

Claim 70 stands or falls alone.

Claim 73 stands or falls alone.

Claim 74 stands or falls alone.

The reasons why each group of claims is believed to be separately patentable are

explained below in the Argument.

## VIII. ARGUMENT

### Claims 1-3, 7, 8, 12-15 and 18-22:

Claim 1 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer et al. (U.S. Pat. 5,627,517) (hereinafter “Theimer”) in view of DeRoche (U.S. Pat. 6,429,810). Appellant asserts that the rejection of claim 1 is not supported by the prior art for at least the following reasons.

**The combination of Theimer and De Roche is improper because Theimer explicitly teaches away from the use of a central server.** The Examiner admits that Theimer does not teach the use of a central server, but states that it would have been obvious to modify Theimer’s system according to De Roche “so that each individual local tracking system located at each of multiple distribution centers of Theimer ... can communicate the items shipping status with each other through centralized server.” Office Action, p. 4. However, the Examiner’s combination of Theimer and De Roche is directly counter to the explicit teachings of Theimer. “The general principle behind [Theimer’s teachings] is that each package is ultimately responsible for its own fate in the distribution system, as opposed to a centralized system” for tracking packages. (Theimer - col. 3, lines 47-51) (emphasis added). Thus, Theimer explicitly states that its teachings are “opposed to” a centralized tracking system such as in De Roche. Also, at col. 1, Theimer discusses the disadvantages of centralized systems (such as De Roche). Theimer further teaches that as much intelligence as possible should remain with the tag (as opposed to a centralized system). (Theimer -- col. 8, lines 41-43). Even Theimer’s title refers to a decentralized tracking and routing system. Thus, Theimer explicitly teaches away from using a central server as in De Roche. References that teach away cannot serve to create a prima facie case of obviousness. *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1131, 1132 (Fed. Cir. 1994). It is improper to combine references where the

references teach away from their combination. *In re Grasselli*, 218 USPQ 769, 779 (Fed. Cir. 1983).

**Furthermore, even if Theimer and De Roche were properly combinable, they do not teach or suggest the central server generating a data file comprising the intermediate and final destination information, and the central server transferring the data file over a network and storing the data file in a memory device that accompanies the item.** As explained in Appellant's previous Appeal Brief, these limitations are clearly not taught or suggested by Theimer. Nor are they taught by De Roche or any combination of Theimer and De Roche. The Examiner refers to server 303 in De Roche as a centralized server. Server 303 is part of De Roche's ground tracking system 304. De Roche does not teach that its server transfers a data file comprising destination information over a network and storing such a data file in the PCS tag 313. Thus, neither Theimer nor De Roche, alone or in combination, teach or suggest the central server generating a data file comprising the intermediate and final destination information, and the central server transferring the data file over a network and storing the data file in a memory device that accompanies the item.

**Moreover, the Examiner has not provided sufficient evidence to show that De Roche constitutes prior art to Appellant's application.** The statute clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). The Examiner has not meet this burden of proof because the Examiner has not shown that De Roche constitutes prior art to Appellant's application. Applicant's application was filed before the Jan. 31, 2001 filing date of De Roche. De Roche does claim priority to two provisional applications which were filed prior to Appellant's application. However, only the material that is common to both the De Roche patent and one of the two earlier filed provisional applications is eligible as potential prior art. *In re Wertheim*, 209 USPQ 554 (CCPA 1981). There is no requirement, and thus no guarantee, that all the content of the De



Roche utility application was also present in the provisional applications. Therefore, the Examiner has not established that the teachings of De Roche upon which his rejection is based are actually prior art to Appellant's application.

Furthermore, under 35 U.S.C. 119(e)(1), the De Roche patent is not entitled to a provisional application's filing date as a prior art date unless at least one claim of the De Roche patent is supported (under 35 U.S.C. § 112) in the provisional application. The Examiner has not shown that this requirement is met. Therefore, the Examiner has not met the necessary burden of proof to reject Appellant's claims.

**Claim 4:**

Claim 4 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of DeRoche. In addition to the reasons stated in regard to claim 1, claim 4 is further distinguishable over the cited art because Theimer and De Roche do not teach forwarding copies of at least a portion of the data file via the network to one or more parties involved in the shipping, wherein the parties include at least an originator of the request to ship the item, a recipient of the item at the final destination, and two or more shipping companies. As explained in Appellant's previous Appeal Brief, these limitations are clearly not taught or suggested by Theimer. With no explanation other than referring to Fig. 1 of De Roche, the Examiner states that Theimer, as modified to include De Roche's centralized server, can now perform these limitations of claim 4. However, there is absolutely no teaching or suggestion in De Roche that its server forwards copies of at least a portion of the data file via the network to one or more parties involved in the shipping, wherein the parties include at least an originator of the request to ship the item, a recipient of the item at the final destination, and two or more shipping companies. Therefore, the rejection of claim 4 is unsupported by the teachings of the cited art.

**Claim 5:**

Claim 5 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of DeRoche. In addition to the reasons stated in regard to claim 1, claim 5 is further distinguishable because the cited art does not teach or suggest forwarding copies of the data file via the network to one or more predetermined email addresses. The Examiner refers to col. 5, lines 1-10, of De Roche. However, this portion of De Roche refers to sending booking notices via e-mail. Sending booking notices via email does not suggest that copies of the data file that is stored in the memory device accompanying the item being shipped are forwarded to one or more predetermined email addresses. Neither Theimer nor De Roche suggest that the booking notices would be stored in the tag that accompanies the item being shipped.

**Claim 9:**

Claim 9 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of DeRoche. In addition to the reasons stated in regard to claim 1, claim 9 is further distinguishable because the cited art does not teach receiving the carrier at a first intermediate destination, removing the container from the carrier, and inserting the container into a different carrier with a second set of additional containers bound for a second intermediate destination or the final destination. The Examiner refers to col. 8, lines 20-23 of Theimer. Neither this nor any other portion of Theimer makes any mention of moving the container to a different carrier with a second set of containers at an intermediate destination. Nor does De Roche contain any such teaching.

**Claim 10:**

Claim 10 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of DeRoche. In addition to the reasons stated in regard to claim 1, claim 10 is further distinguishable because the cited art does not teach the data file generated by the central server further comprises contact information for one or more shipping companies that will handle the item. The Examiner refers to col. 7, lines 5-12, but does not indicate which reference. Neither this nor any other portion of Theimer or De Roche

makes any mention of a data file generated by a central server comprising contact information for one or more shipping companies that will handle the item.

**Claim 11:**

Claim 11 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of DeRoche. In addition to the reasons stated in regard to claim 1, claim 11 is further distinguishable because the cited art does not teach storing the data file on a server connected to the network, wherein the server provides access to the data file via the network. The Examiner refers to col. 3, line 67 to col. 4, line 5 of De Roche. This portion of refers to obtaining status information. Neither this nor any other portion of Theimer makes any mention of storing the data file (as specified in claim 1 that is stored in the memory device accompanying the item being shipped) on a server connected to the network, wherein the server provides access to the data file via the network.

**Claims 16 and 17:**

Claims 16 and 17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of De Roche and further in view of Ross et al. (U.S. Pat. 6,332,098) (hereinafter “Ross”). In addition to the reasons stated in regard to claim 1, claims 16 and 17 are further distinguishable because the cited art does not teach or suggest that the data file which is stored in the memory device that accompanies the item (per claim 1) includes one or more digital images of the item. Ross does teach taking digital images of an item. However, Ross does not teach storing those digital images in memory devices accompanying the items. Ross describes tags for storing information such as weight, but it is the “arch or zone” in Ross that takes the digital images. Ross does not teach that these digital images are ever stored in the tags. Nor does the cited art provide any motivation to modify the tags of Theimer or De Roche to include digital images.

**Claim 23:**

Claim 23 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of DeRoche. In addition to the reasons stated in regard to claim 1, claim 23 is further distinguishable because the cited art does not teach detecting one or more obstacles to on-time delivery of the item and searching the database for a new least expensive routing that avoids the obstacles, wherein the database is the same database searched by the central server to locate the most inexpensive routing. The portion of Theimer cited by the Examiner does discuss the tag performing a rescheduling operation. However, Theimer does not teach that the tag searches the same database that was searched by a central server to locate the original most inexpensive route. Nor does De Roche contain any such teaching or suggestion.

**Claim 28:**

Claim 28 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of DeRoche. In addition to the reasons stated in regard to claim 1, claim 28 is further distinguishable because the cited art does not teach updating the data file on the central server to reflect arrival of the item at one or more of the intermediate destinations. Although De Roche does teach that location status information may be obtained, De Roche does not teach that such information is provided as updates to the data file which was stored in the memory device accompanying the item being shipped.

**Claim 41:**

Claim 41 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of DeRoche. In addition to the reasons stated in regard to claim 1, claim 41 is further distinguishable because the cited art does not teach that the memory device is a flash memory device. The Examiner refers to the active memory 230 of Theimer's tag. However, there are many kinds of active memory. Nowhere does Theimer teach or suggest that its active memory is a flash memory device. Nor does De Roche teach or suggest the use of flash memory for this purpose.

**Claim 42:**

Claim 42 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of DeRoche. In addition to the reasons stated in regard to claim 1, claim 42 is further distinguishable because the cited art does not teach that the memory device is a CD-RW (compact disc - rewritable). The Examiner refers to the active memory 230 of Theimer's tag. However, there are many kinds of active memory. Nowhere does Theimer teach or suggest that its active memory is a CD-RW. Nor does De Roche teach or suggest the use of a CD-RW for this purpose.

**Claim 44:**

Claim 44 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of De Roche and further in view of Shavit et al. (U.S. Pat. 4,799,156) (hereinafter "Shavit"). In addition to the reasons stated in regard to claim 1, claim 44 is further patentable because the references are not properly combinable. As discussed above, Theimer explicitly teaches away from using a centralized system. Shavit teaches a centralized interactive market management system. In light of the explicit teaching away in Theimer from centralized systems, one of ordinary skill in the art would not look to combine the teaches of Theimer, De Roche and Shavit. "It is improper to combine references where the references teach away from their combination." *In re Graselli*, 218 USPQ 769, 779 (Fed. Cir. 1983). Therefore, the rejection based on the combination of Theimer, De Roche and Shavit is improper.

**Claim 45:**

Claim 45 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of De Roche and further in view of Shavit. In addition to the reasons stated in regard to claim 1, claim 45 is further patentable because the request for quote sent out in Shavit is not for selecting an alternate shipping route in response to detecting

one or more obstacles to on-time delivery of the item. Furthermore, the centralized system of Shavit is not properly combinable with the decentralized tags of Theimer. As discussed above in regard to claim 44, one of ordinary skill in the art would not look to the centralized system of Shavit in light of the explicit teaching away from such systems in Theimer. Thus, the combination of Shavit with Theimer and De Roche is improper.

**Claim 46:**

Claim 46 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of De Roche and further in view of Shavit. In addition to the reasons stated in regard to claims 1 and 45, claim 46 is further patentable because the cited art does not teach or suggest that the obstacles include travel advisories for one or more of the intermediate locations. The advisory in Shavit is for a broken truck, not a travel advisory (e.g. weather related). Furthermore, the advisory in Shavit is not an obstacle that is detected and in response to which an alternate route is selected.

**Claim 47:**

Claim 47 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of De Roche and further in view of Shavit. In addition to the reasons stated in regard to claims 1 and 45, claim 47 is further patentable because the cited art does not teach or suggest that the obstacles include shipping backlogs. The portion of Theimer cited by the Examiner refers to an airplane delay, not a shipping backlog.

**Claim 49:**

Claim 49 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of DeRoche. In addition to the reasons stated in regard to claim 1, claim 49 is further distinguishable because the cited art does not teach or suggest updating the data file on the central server to reflect the item's arrival at the final destination. Although De Roche does teach that location status information may be obtained, De

Roche does not teach that such information is provided as an update to the data file which was stored in the memory device accompanying the item being shipped.

**Claim 50:**

Claim 50 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over DeRoche in view of Theimer. Appellant traverse this rejection for at least the following reasons.

**The combination of De Roche and Theimer is improper because Theimer explicitly teaches away from the use of a central server.** The Examiner's combination of De Roche and Theimer is directly counter to the explicit teachings of Theimer. "The general principle behind [Theimer's teachings] is that each package is ultimately responsible for its own fate in the distribution system, as opposed to a centralized system" for tracking packages. (Theimer -- col. 3, lines 47-51) (emphasis added). Thus, Theimer explicitly states that its teachings are "opposed to" a centralized tracking system such as in De Roche. Also, at col. 1, Theimer discusses the disadvantages of centralized systems (such as De Roche). Theimer further teaches that as much intelligence as possible should remain with the tag (as opposed to a centralized system). (Theimer -- col. 8, lines 41-43). Even Theimer's title refers to a decentralized tracking and routing system. Thus, Theimer explicitly teaches away from applying its teachings to a central server system as in De Roche. References that teach away cannot serve to create a prima facie case of obviousness. *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1131, 1132 (Fed. Cir. 1994). It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 218 USPQ 769, 779 (Fed. Cir. 1983).

**Furthermore, even if De Roche and Theimer were properly combinable, they do not teach or suggest to confirm the selected shipping route via the network, as recited in claim 50.** Theimer does not teach that any confirmation of a selected shipping route is performed. Nor does De Roche. The portion of De Roche cited by the Examiner

refers to sending booking notices and shipping instructions, not confirming a selected shipping route.

**Furthermore, De Roche and Theimer do not teach or suggest to generate a data file comprising origination information, to transfer the data file over the network on which the shipping request was received, and store the data file in a memory device that accompanies the item as recited in claim 50.** The Examiner refers to col. 5, lines 3-7 of De Roche. However, this portion of De Roche describes sending booking notices and shipping instructions to the transit companies. This teaching in De Roche in no way suggests generating a data file that is stored on a memory device accompanying the item being shipped. The Examiner also refers to Theimer. However, the focus of Theimer is on the tags being able to check destination codes. Thus, there is no need for the tags in Theimer to include origination information. The portion of Theimer cited by the Examiner describes a route by which a package may be sent, but it does not teach that the tag would store origination information. Theimer never discusses any need for the tags to include origination information.

**Moreover, the Examiner has not provided sufficient evidence to show that De Roche constitutes prior art to Appellant's application.** The statute clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). The Examiner has not meet this burden of proof because the Examiner has not shown that De Roche constitutes prior art to Appellant's application. Applicant's application was filed before the Jan. 31, 2001 filing date of De Roche. De Roche does claim priority to two provisional applications which were filed prior to Appellant's application. However, only the material that is common to both the De Roche patent and one of the two earlier filed provisional applications is eligible as potential prior art. *In re Wertheim*, 209 USPQ 554 (CCPA 1981). There is no requirement, and thus no guarantee, that all the content of the De Roche utility application was also present in the provisional applications. Therefore, the



Examiner has not established that the teachings of De Roche upon which his rejection is based are actually prior art to Appellant's application.

Furthermore, under 35 U.S.C. 119(e)(1), the De Roche patent is not entitled to a provisional application's filing date as a prior art date unless at least one claim of the De Roche patent is supported (under 35 U.S.C. § 112) in the provisional application. The Examiner has not shown that this requirement is met. Therefore, the Examiner has not met the necessary burden of proof to reject Appellant's claims.

**Claim 51:**

Claim 51 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of De Roche and further in view of Shavit. In addition to the reasons stated in regard to claim 50, claim 51 is further distinguishable because the cited art does not teach maintaining and updating the database by sending requests for quotes using the network. The portion of Shavit cited by the Examiner simply states that a data base may include requests for quotes. Shavit does not teach maintaining and updating a database by sending requests for quotes using the network. Also, as noted above for claim 44, the combination of Theimer, De Roche and Shavit is improper in light of the explicit teaching away in Theimer from centralized systems such as in Shavit and De Roche.

**Claims 53, 63 and 66:**

Claim 53 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over DeRoche in view of Theimer. Appellant traverse this rejection for at least the following reasons.

**The combination of De Roche and Theimer is improper because Theimer explicitly teaches away from the use of a central server.** The Examiner's combination of De Roche and Theimer is directly counter to the explicit teachings of Theimer. "The general principle behind [Theimer's teachings] is that each package is ultimately

responsible for its own fate in the distribution system, as opposed to a centralized system” for tracking packages. (Theimer -- col. 3, lines 47-51) (emphasis added). Thus, Theimer explicitly states that its teachings are “opposed to” a centralized tracking system such as in De Roche. Also, at col. 1, Theimer discusses the disadvantages of centralized systems (such as De Roche). Theimer further teaches that as much intelligence as possible should remain with the tag (as opposed to a centralized system). (Theimer -- col. 8, lines 41-43). Even Theimer’s title refers to a decentralized tracking and routing system. Thus, Theimer explicitly teaches away from applying its teachings to a central server system as in De Roche. References that teach away cannot serve to create a prima facie case of obviousness. *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1131, 1132 (Fed. Cir. 1994). It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 218 USPQ 769, 779 (Fed. Cir. 1983).

**Furthermore, even if De Roche and Theimer were properly combinable, they do not teach or suggest a central server configured to generate a data file including information identifying an origination, destination, and intermediate destination comprised in the shipping route; and a memory device configured to be coupled to the item and configured to receive and store a copy of the data file generated by the central server, as recited in claim 53.** The Examiner refers to col. 5, lines 3-7 of De Roche. However, this portion of De Roche describes sending booking notices and shipping instructions to the transit companies. This teaching in De Roche in no way suggests generating a data file that is stored on a memory device accompanying the item being shipped. The Examiner also refers to Theimer. However, the focus of Theimer is on the tags being able to check destination codes. Thus, there is no need for the tags in Theimer to include origination information. The portion of Theimer cited by the Examiner describes a route by which a package may be sent, but it does not teach that the tag would store origination information. Theimer never discusses any need for the tags to include origination information.

**Moreover, the Examiner has not provided sufficient evidence to show that De Roche constitutes prior art to Appellant's application.** The statute clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). The Examiner has not meet this burden of proof because the Examiner has not shown that De Roche constitutes prior art to Appellant's application. Applicant's application was filed before the Jan. 31, 2001 filing date of De Roche. De Roche does claim priority to two provisional applications which were filed prior to Appellant's application. However, only the material that is common to both the De Roche patent and one of the two earlier filed provisional applications is eligible as potential prior art. *In re Wertheim*, 209 USPQ 554 (CCPA 1981). There is no requirement, and thus no guarantee, that all the content of the De Roche utility application was also present in the provisional applications. Therefore, the Examiner has not established that the teachings of De Roche upon which his rejection is based are actually prior art to Appellant's application.

Furthermore, under 35 U.S.C. 119(e)(1), the De Roche patent is not entitled to a provisional application's filing date as a prior art date unless at least one claim of the De Roche patent is supported (under 35 U.S.C. § 112) in the provisional application. The Examiner has not shown that this requirement is met. Therefore, the Examiner has not met the necessary burden of proof to reject Appellant's claims.

**Claim 54:**

Claim 54 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of De Roche and further in view of Shavit. In addition to the reasons stated in regard to claim 53, claim 54 is further distinguishable because the cited art does not teach that the central server is configured to update the database in response to receiving one or more responses to a request for quote from one or more shipping companies. The portion of Shavit cited by the Examiner simply states that a data base may include requests for quotes. Shavit does not teach updating a database in response to

receiving one or more responses to a request for quote from one or more shipping companies. Also, as noted above for claim 44, the combination of Theimer, De Roche and Shavit is improper in light of the explicit teaching away in Theimer from centralized systems such as in Shavit and De Roche.

**Claim 55:**

Claim 55 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over De Roche in view of Theimer. In addition to the reasons stated in regard to claim 53, claim 55 is further distinguishable because the cited art does not teach that the central server is configured to confirm the shipping route prior to providing the data file to the memory device. The Examiner cites col. 5, lines 1-3 of De Roche. However, this portion of De Roche does not teach a central server that is configured to confirm the shipping route prior to providing the data file to the memory device. The shipper agreeing to the services and the booking notices and shipping instructions being sent does not necessarily mean that the shipping route has been confirmed.

**Claim 56:**

Claim 56 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over De Roche in view of Theimer. In addition to the reasons stated in regard to claim 53, claim 56 is further distinguishable because the cited art does not teach that the central server is configured to receive confirmation of arrival of the item at the intermediate destination and to responsively update the data file to indicate that the item has arrived at the intermediate destination. Although De Roche does teach that location status information may be obtained, De Roche does not teach that such information is provided as an update to the data file which was stored in the memory device accompanying the item being shipped.

**Claim 57:**

Claim 57 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over De Roche in view of Theimer. In addition to the reasons stated in regard to claims 53 and 56, claim 57 is further patentable for reasons similar to those discussed above in regard to claim 5.

**Claim 58:**

Claim 58 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over De Roche in view of Theimer. In addition to the reasons stated in regard to claims 53 and 56, claim 58 is further distinguishable because the cited art does not teach that the central server is configured to search the database for a less expensive shipping route from the intermediate destination to the final destination in response to the item arriving at the intermediate destination. The Examiner cites col. 9, lines 30-45 of Theimer. However, this portion of Theimer refers to the operation of an individual decentralized package tag, not a central server. Moreover, the cited portion of Theimer does not teach that the tag searches for a less expensive shipping route from the intermediate destination to the final destination in response to the item arriving at the intermediate destination.

**Claim 59:**

Claim 59 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over De Roche in view of Theimer. In addition to the reasons stated in regard to claim 53, claim 59 is further distinguishable because the cited art does not teach a processing apparatus located at the intermediate destination, wherein the processing apparatus is configured to update the data file stored on the memory device in response to the item arriving the intermediate destination. The Examiner cites col. 5, lines 23-37 of De Roche. However, this portion of De Roche does not mention anything about a processing apparatus located at the intermediate destination, wherein the processing apparatus is configured to update the data file stored on the memory device in response to the item arriving the intermediate destination.

**Claim 60:**

Claim 60 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over De Roche in view of Theimer. In addition to the reasons stated in regard to claim 53, claim 60 is further distinguishable because the cited art does not teach that the central server is configured to select a least expensive shipping route. The Examiner states that De Roche teaches the shipper selecting a least expensive shipping route. However, claim 60 recites that the central server, not the shipper, selects the least expensive shipping route.

**Claim 61:**

Claim 61 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over De Roche in view of Theimer. In addition to the reasons stated in regard to claim 53, claim 61 is further distinguishable over the cited art for reasons similar to those discussed in regard to claim 10 above.

**Claim 62:**

Claim 62 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over De Roche in view of Theimer. In addition to the reasons stated in regard to claim 53, claim 62 is further distinguishable over the cited art for reasons similar to those discussed in regard to claim 11 above.

**Claims 64 and 65:**

Claims 64 and 65 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of De Roche and further in view of Ross. In addition to the reasons stated in regard to claim 53, claims 64 and 65 are further patentable for reasons similar to those discussed in regard to claims 16 and 17 above.

**Claim 67:**

Claim 67 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over De Roche in view of Theimer. In addition to the reasons stated in regard to claim 53, claim 67 is further distinguishable because the cited art does not teach that the central server is configured to detect one or more obstacles to on-time delivery of the item, to responsively search the database for a new least expensive routing that avoids the one or more obstacles; and to update the data file to indicate the new least expensive routing. The Examiner cites col. 9, lines 15-28, of Theimer. However, this portion of Theimer refers to the operation of an individual package tag, not a central server. De Roche does not suggest a central server configured to perform these functions.

**Claim 68:**

Claim 68 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of De Roche and further in view of Shavit. In addition to the reasons stated in regard to claim 53, claim 68 is further patentable for reasons similar to those discussed in regard to claim 45 above.

**Claim 69:**

Claim 69 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over De Roche in view of Theimer. In addition to the reasons stated in regard to claim 53, claim 69 is further distinguishable because the cited art does not teach that the central server is configured to update the data file to reflect arrival of the item at the final destination. The portion of De Roche cited by the Examiner does not teach that the central server is configured to update the data file which was stored in the memory device accompanying the item being shipped.

**Claim 70:**

Claim 70 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over De Roche in view of Theimer. In addition to the reasons stated in regard to claim 53,

claim 70 is further distinguishable because the cited art does not teach that the item is included in a group of items, and wherein the central server is configured to select different shipping routes on which to ship different subsets of the group of items. The Examiner cites col. 7, lines 45-48 of Theimer. Fig. 3 of Theimer does show a group of items. However, Theimer does not teach to select different shipping routes on which to ship different subsets of the group of items. Neither does De Roche.

**Claim 73:**

Claim 73 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of De Roche and further in view of Shavit. In addition to the reasons stated in regard to claim 45, claim 73 is further patentable because the cited art does not teach the central server updating the database in response to said receiving the additional responses. The portion of De Roche cited by the Examiner mentions nothing about updating a database in response to receiving additional responses to a request for shipping quotation for shipping via a network.

**Claim 74:**

Claim 74 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of De Roche. In addition to the reasons stated in regard to claim 1, claim 74 is further distinguishable because the cited art does not teach the central server selecting one shipping route on which to ship a subset of the group of items and another shipping route on which to ship a remainder of the group of items. The Examiner cites col. 7, lines 45-48. Fig. 3 of Theimer does show a group of items. However, Theimer does not teach selecting one shipping route on which to ship a subset of the group of items and another shipping route on which to ship a remainder of the group of items. Nor does De Roche.

**IX. CONCLUSION**



For the foregoing reasons, it is submitted that the Examiner's rejection of claims 1-5, 7-23, 28, 41, 42, 44-47, 49-51, 53-70, 73 and 74 was erroneous, and reversal of the Examiner's decision is respectfully requested.

This Appeal Brief is submitted in triplicate along with the following items:

- ☒ Return Receipt Postcard
- ☒ Request for Reinstatement of Appeal

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account No. 50-1505/5596-00400/RCK.

Respectfully submitted,



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Date: March 3, 2004

## **X. APPENDIX**

The Appendix from the original Appeal Brief is herein incorporated by reference.